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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Serial No.: 10/782,794

Confirmation No.: 6789

In re Application of:

Mark Roland BOEDER

Group Art Unit: 1661

Filed: February 23, 2004

Examiner: Kent L. Bell

For: CHRYSANTHEMUM PLANT NAMED 'CETWOTONE PINK'

REPLY BRIEF

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REPLY BRIEF

Pursuant to 37 CFR §41.41, appellant files this Reply Brief to the Examiner's Answer mailed July 16, 2008.

I. THE REJECTION ON APPEAL

The Examiner's Answer ("EA"), page 2, (EA - 2 at (6)) states that "appellant's statement of the grounds of rejection to be reviewed on appeal is correct." See Appellant's Brief on Appeal (May 5, 2008), page 3. And this is further confirmed by the restatements of the rejection on appeal appearing at EA-1-2, and EA-12, last four lines.

The rejection is not based upon Karim, EconPort or CBA Sales documents listed at EA-3, or the arguments based thereon at EA-5, second paragraph, through EA-7, first four lines, all of which should be ignored by this honorable Board.

II. ADMITTED SALES OUTSIDE THE UNITED STATES

An important aspect of appellant's position in this appeal is that while appellant has admitted that the claimed plant was sold outside the United States, in the Netherlands more than one year before the filing date of this application on appeal, appellant has never admitted that the claimed plant was then on sale or even available to or in possession of the public in the United States, and there is no evidence to the contrary in this record. Cf., EA-11, last two lines. Appellant has not admitted that the aforementioned sales outside the United States are prior art to the present application.

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III. THE EXAMINER'S ANSWER "Response(s) to
[Appellant's] Argument" ARE NOT PERSUASIVE

The "Response to [Appellant's] Argument" in the Examiner's Answer (EA-7-13) repeatedly rely on the following conclusory propositions, which appellants continue to assert are erroneous and contrary to controlling statute and Federal Circuit precedents:

(a). The Alleged Law -- because the claimed plant was on sale outside the United States, it was therefore allegedly accessible "to the public" (even though this record contains no evidence that it was in fact accessible in the United States), and accessibility anywhere in the world allegedly makes the plant material available to and "known" by one of skill in the relevant art.

(b). The Alleged Facts -- the European PBR published February 15, 2002 (which alone is not enabling, a fact never challenged by the PTO), is allegedly "enabled" by the admitted August 2002 sales of the claimed plant, which occurred only outside the United States.

A. THE ALLEGED LAW

The Examiner's Answer cites as its legal bases 35 U.S.C. §102(b), and prior Federal Circuit, CCPA and Board decisions, In re LeGrice, 301 F2d 929, 133 USPQ 365 (CCPA 1962); Ex parte Thomson, 24 USPQ2d 1618 (Bd. Pat. App. & Interf. 1992); In re Elsner, 381 F3d 1125, 72 USPQ2d 1038 (Fed. Cir. 2004); In re Samour, 571 F2d 559, 197 USPQ 1 (CCPA 1978); and In re Donohue (II), 766 F2d 531, 226 USPQ 619 (Fed. Cir. 1985). However, both Elsner and Thomson erroneously cite and extrapolate from the facts and holdings in LeGrice, Samour, and Donohue.

1. LeGrice

In In re LeGrice, 301 F2d 929 (CCPA 1962) foreign publications depicted and related to the identical roses sought to be patented in a U.S. plant patent application, but no evidence of

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sales of such roses was of record. The Court reversed the PTO rejection under 35 USC §102(b) over the foreign publications because they were not enabling. The court said and quoted the U.S. Supreme Court:

We think the controlling view here is that stated in Seymour v. Osborne, 11 Wall. 516, at page 555, 78 U.S. 516, at page 555, 20 L. Ed. 33 (1870), where the court said:

“Patented inventions cannot be superseded by the mere introduction of a foreign publication of the kind, though of prior date, unless the description and drawings contain and exhibit a substantial representation of the patented improvement, in such full, clear, and exact terms as to enable any person skilled in the art or science to which it appertains, to make, construct, and practice the invention to the same practical extent as they would be enabled to do if the information was derived from a prior patent. Mere vague and general representations will not support such a defence, as the knowledge supposed to be derived from the publication must be sufficient to enable those skilled in the art or science to understand the nature and operation of the invention, and to carry it into practical use. Whatever may be the particular circumstances under which the publication takes place, the account published, to be of any effect to support such a defence, must be an account of a complete and operative invention capable of being put into practical operation.”

* * *

[B]efore any publication can amount to a statutory bar to the grant of a patent, its disclosure must be such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention. Such a doctrine is in accord with that expressed by the Supreme Court when it held patent No. 137,893 invalid in Cohn v. United States Corset Co., 93 U.S. 366, 23 L. Ed. 907[1877].

LeGrice, 301 F2d at 936. Still further, the LeGrice court said:

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[T]he proper test of a description in a publication as a bar to a patent as the clause is used in section 102(b) requires a determination of whether one skilled in the art to which invention pertains could take the description of the invention in the printed publication and combine it with his own knowledge of the particular art and from this combination be put in possession of the invention on which a patent is sought. Unless this condition prevails, the description in the printed publication is inadequate as a statutory bar to patentability under section 102(b).

301 F2d at 939; emphasis added here. Finally, the LeGrice court, said:

The mere description of the plant is not necessarily an "enabling" disclosure. Such descriptions, just as in the case of other types of inventions, in order to bar issuance of a patent, must be capable, when taken in conjunction with the knowledge of those skilled in the art to which they pertain, of placing the invention in the possession of those so skilled.

301 F2d at 944; emphasis added here.

2. Thomson

In 1992, in Thomson, the Board relied only upon Donohue (II), which it quoted:

"It is well settled that prior art under 35 USC 102(b) must sufficiently describe the claimed invention to have placed the public in possession of it Such possession is effected if one of ordinary skill in the art could have combined the publication's description of the invention with his own knowledge to make the claimed invention Accordingly, even if the claimed invention is disclosed in the printed publication, that disclosure will not suffice as prior art if it was not enabling."

Thomson, 24 USPQ2d at 1619, quoting Donohue (II), 766 F2d at 533. But subsequently, the Board said:

The issue is not whether the cultivar Siokra was on public use or sale in the United States but, rather, whether Siokra seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the Siokra cultivar disclosed in the cited publications.

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Ibid., at 1620; emphasis added here. No authority was cited in Thomson for the Board's expansive language "anywhere in the world." Cf., EA bridging pages 10-11. And, the Board concluded:

Manifestly, it is reasonable to conclude that, at the time the cited articles were published, skilled artisans throughout the world would have found Siokra seeds readily available on the open market. Again, there is no evidence of record to the contrary.

Id. No authority was cited for the expansive "throughout the world" language.

3. Donohue (II)

In Donohue (II) a §102(b) rejection was based upon a Nomura printed publication (not foreign sales) which fully disclosed all elements of the claimed compounds. Two additional printed publications, a Lincoln patent and a Wagner article, were cited to show that the method of making the Nomura compounds would have been within the knowledge of one of ordinary skill in the art. None of those cited publications or patents was evidence outside the United States.

4. Elsner

In Elsner the Federal Circuit also relied upon LeGrice, Donohue (II), and Samour, and said:

When a publication identifies the plant that is invented or discovered and a foreign sale occurs that puts one of ordinary skill in the art in possession of the plant itself, which, based on the level of ordinary skill in the art, permits asexual reproduction without undue experimentation, that combination of facts and events so directly conveys the essential knowledge of the invention that the sale combines with the publication to erect a statutory bar.

Elsner, 381 F2d at 1129; emphasis added here.

[T]he precise focus of the analysis is not whether the foreign sales are themselves §102(b) prior art, but whether the publication has placed the claimed invention in the possession of the public before

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the critical date. Thus, foreign sales of the claimed plants may be within the knowledge of the skilled artisan and may be considered to provide the public with access to Appellants' inventions.

Id., at 1129-30; emphasis added here. Note that "may" does not mean "is" or "must" – additional proof is often required. Cf., EA bridging pages 11-12. And indeed in Elsner the Federal Circuit vacated the Board's decision and remanded "for further factual findings relating to the accessibility of the foreign sales" Ibid., at 1131.

5. Samour

In Samour a §102(b) rejection was based on a Doran printed publication (not foreign sales) which disclosed the claimed compounds, but with a notation indicating that such compounds were "without effect" or "without activity." Three other references, Fuyunga and Henge et al. articles, and a Wagner patent, were cited to show that one of ordinary skill in the art would have known how to make the Doran compounds. None of this evidence was outside the United States.

Furthermore, none of the cases cited in Samour with respect to "in possession of the public" considered evidence which was outside the United States. See, In re Coker, 463 F2d 1344, 175 USPQ 26 (CCPA 1972); In re Wilder, 429 F2d 447, 166 USPQ 545 (CCPA 1970); In re Brown, 329 F2d 1006, 141 USPQ 245 (CCPA 1964); and In re LeGrice.

But the court in Samour did say:

Whether the claimed subject matter was in possession of the public depends on whether a method of preparing the claimed subject matter would have been known by, or would have been obvious to, one of ordinary skill in the pertinent art. In re Brown, supra, 329 F2d at 1011 51 CCPA at 1260, 141 USPQ at 249; see In re Coker, supra; In re Hoeksema, 399 F2d 269, 55 CCPA 1493, 158 USPQ 596 (1968).

Samour, 521 F2d at 562, emphasis added here.

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B. THE IGNORED BUT CONTROLLING LAW

The assertions of the Court in Elsner, the Board in Thomson, and the PTO in this appeal, all rush to conclusions that ignore the statutes §102(b) and §103(a), and ignore the statutory words “prior art” and “one of ordinary skill in the art.”

1. “Prior Art”

Those statutes, and the Federal Circuit have emphasized the meaning of the term “prior art,” as follows:

It [knowledge] is [presumably] available, in legal theory at least, when it is described in the world’s accessible literature, including patents, or has been publicly known or in the public use or on sale “in this country.” 35 U.S.C. §102(a) and (b). That is the real meaning of “prior art” in legal theory – it is knowledge that is available, including what would be obvious from it, at a given time, to a person of ordinary skill in an art.

Kimberly-Clark Corp. v. Johnson & Johnson, 745 F2d 1437, 1453 (Fed. Cir. 1984); bracketed matter added here.

2. “Person having ordinary skill in the art”

[B]y law . . . the hypothetical person of ordinary skill in the art . . . is charged with knowledge of all the contents of the relevant prior art.

In re Carlson, 983 F2d 1032, 1037, 25 USPQ2d 1207 (Fed. Cir. 1992). Conversely, knowledge or art that is not prior to the invention date of a particular claimed invention is for that case not presumed to be known by the hypothetical person of ordinary skill in the relevant art.

3. In possession of the public in this country

As explained above in Kimberly-Clark, knowledge arising from from “on sale” of claimed subject matter is accorded “prior art” status only when that subject matter is “on sale in this country,” per 35 U.S.C. §102(b). Cf., EA-9, lines 8-16. A hypothetical person of ordinary

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skill in the relevant art -- who is defined only by knowledge of prior art -- cannot as a result of foreign sales alone be presumed to have knowledge which was made public only outside this country by such foreign sales. Stated otherwise, knowledge gained as a result of foreign sales alone cannot trump the clear statutory limitation of “on sale in this country” in §102(b) by erroneously asserting that such knowledge is knowledge of one of ordinary skill in the art.

Cases like LeGrice, 301 F2d at 939 (quoted at p. 3, supra); Donohue (II), 766 F2d at 533 (quoted at p. 4, supra); and Samour, 521 F2d at 562 (quoted at p. 6, supra) made the point that the public will have possession of claimed subject matter if the description thereof in a printed publication, taken with the knowledge of one of ordinary skill in the art, would make that claimed subject matter known or obvious to that one of ordinary skill in the art. Where, as here, as a matter of law (as explained immediately above in this sub-part 3.), knowledge of such subject matter which exists only as a result of foreign sales simply is not knowledge of the hypothetical person of ordinary skill in the art. This logically makes the meaning of the phrase “in possession of the public” in fact be “in possession of the public in this country.”

**C. THE FACTS IN THIS RECORD DO NOT SHOW
PUBLIC POSSESSION IN THIS COUNTRY
OF APPELLANT'S CLAIMED PLANT**

The record of the prosecution of the instant application contains two responses by appellant to PTO requirements for information under 37 CFR §1.105. These responses were filed January 24, 2005 and June 2, 2005 and in essence state that applicant's assignee

. . . never discloses information regarding varieties under registration [the subject of a pending application for PBR] to third parties, regardless of how the plant is denominated in those initial [PBR application] papers.

See Reply to Requirement . . . , June 2, 2005, page 2. That reply demonstrated that even if one contacted appellant's assignee and inquired about purchasing the plant identified in the PBR

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application, appellant's assignee would not have, and in fact did not, provide to third parties any information concerning such plant. Cf., EA bridging pages 5-7.

Additionally, the admitted August 2002 sale, in the Netherlands, outside the United States, occurred only about six months prior to the February 23, 2003 one year date before the February 23, 2004 filing date of the instant application. It is well known in this art that such plant material cannot be imported into the United States for propagation use without a six-month quarantine period before public dissemination and use. See 7 CFR §319.37 - 1-8, especially 7.

The Examiner's Answer, page 9, responds only that the importation quarantine (which the Examiner's Answer does not deny is required) "has nothing to do with an enabled publication."

A person of ordinary skill in this art could not have had possession of appellant's claimed invention without obtaining a sample of the claimed plant material. Cf., EA-10, lines 6-15. The date of the admitted foreign sale coupled with time for transportation and the mandatory quarantine, would have rendered it impossible for anyone lawfully to have had possession in the United States of the necessary plant material more than one year before the filing date of the instant application. And, there is no evidence in this record of any such possession.

The facts in this record preclude a finding that the lawfully presumed knowledge of one of ordinary skill in the art could have included possession of a sample of the necessary plant material. And thus the public was not in possession of sufficient knowledge at any relevant time to qualify the cited PBR as a lawfully enabled prior art reference effective under §102(b).

IV. CONCLUSION

For all the foregoing reasons, contrary to the PTO positions taken throughout prosecution of the instant application, and contrary to the reasons advanced in the Examiner's Answer in this appeal, neither the cited PBR, nor appellant's admitted sale outside the United States, constitutes de jure prior art that would have enabled the PBR as an effective §102(b) publication against the instant application. Accordingly, for all the foregoing reasons, as well as the reasons advanced

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in appellant's Brief on Appeal, appellant respectfully requests this honorable Board to reverse the rejection below, allow appellant's claim, and pass this application to issue.

Respectfully submitted,

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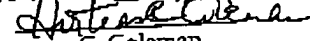
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